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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,099	01/16/2004	Tanya L. Swartz	M61.12-0571	7350

27366 7590 03/26/2007  
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EXAMINER

ALAM, SHAHID AL

ART UNIT PAPER NUMBER

2162

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/760,099

Applicant(s)

SWARTZ ET AL.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                            | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed December 11, 2006 have been fully considered but they are not persuasive for the following reasons.

Applicant argues that a *prima facie* case of anticipation has not been established with respect to claim 1; the cited paragraph does not teach "providing customized metadata defining entities"; the cited paragraph does not mention "metadata" at all; the cited paragraph fails to identically disclose claimed invention; the cited paragraph does not mention "a subscription list", "Subscription metadata", "a subscription data store" or "a mobile computing device" as provided in step c). and the cited paragraph fails to identically disclose the subject matter as claimed.

Applicant's main arguments are that a *prima facie* case of anticipation has not been established and that the cited paragraph fails to identically disclose the subject matter as claimed.

2. Examiner respectfully disagrees all of the allegations as argued. Examiner, in his previous office action, gave detail explanation of claimed limitation and pointed out exact locations in the cited prior art.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111 [R-1]

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

In response to Applicants' argument that Kaenel does not disclose claimed limitations in the cited section (cited location has nothing to do with applicant's invention). Examiner likes to point out that in the "Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002) Decided August 8, 2002."

In the above case it is concluded that the prior art **disclosure need not be express in order to anticipate**. Even if a prior art inventor does not recognize a function of his or her process, **the process can anticipate if that function was inherent**. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and **that it would be so recognized by persons of ordinary skill. Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art.** Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. **Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation.**

Last Office action was an anticipatory rejection. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >“When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” Brown v. 3M, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< “The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required.** In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

To anticipate, a prior art can be an analogous art and the determination of what arts are analogous to a particular claimed invention is that **it depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called by the applicant.** For example, for search purposes, a tea mixer and a concrete mixer may both be regarded as relating to the mixing art, this being the necessary function of each. Similarly a brick-cutting machine and a biscuit cutting machine may be considered as having the same necessary function.

**Drawings and pictures can anticipate claims if they clearly show the structure which is claimed.** In re Mraz, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). However, the picture must show all the claimed structural features and how they are put together. Jockmus v. Leviton, 28 F.2d 812 (2d Cir. 1928). The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents. When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification.

**The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art.** In re Aslanian, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). See MPEP § 2121.04 for more information on prior art drawings as "enabled disclosures."

Examiner cited Figure 15 and Figure 15 shows metadata generation and metadata store and data store and a loading system. Here after generating metadata it is placed in metadata store for storage. Of course, after generating a metadata, user will not delete but should store for later use. Figure 15 shows a table 1513 and that shows Acme Corp. and their metadata being customer name and location information. Customer Name have their metadata as being ABC corp, XYZ Inc. etc.. Since, ABC Corp, XYZ Inc. and Big Corp. are entities and these entities includes metadata as type of building, address, city, these are called metadata defining entity. Likewise, Data Store and Metadata Store are also entity and they store data and metadata which is data about data. Kaenel teaches in Para [0337] that metadata is created and stored in metadata store and utilization of XML or other format by the user (see Para [0329]).

In response to applicant's argument on page 7, a prima facie case of anticipation is established as discussed above and in the last Office action.

For the above reasons, Examiner believed that rejection of the last Office action was proper.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication Number 2004/0117358 A1 issued to Tim von Kaenel et al. (hereinafter "Kaenel").

With respect to claim 1, Kaenel teaches method of customizing a software-implemented business process (paragraph [0465]) comprising:

- a) providing customized metadata defining entities (paragraph [0248]);
- b) storing the customized metadata and data corresponding to the entities in a first data store (paragraph [0324]);
- c) providing a subscription list of the entities, the subscription list being defined by subscription metadata stored in a subscription data store of a mobile computing device (paragraph [0329]);

d) sending the customized metadata corresponding to the entities identified in the subscription list to the mobile computing device (paragraph [0329]); and

e) storing the sent customized metadata in a second data store of the mobile computing device (paragraphs [0065, 0337] and Figure 18).

As to claim 2, sending the data corresponding to the entities identified in the subscription list to the mobile computing device (paragraph [0400]); and storing the sent data in the second data store (paragraph [0324]).

As to claim 3, populating an entity defined by the sent customized metadata with the corresponding sent data (paragraph [0471]).

As to claim 4, displaying the populated entity on the mobile computing device in accordance with a form defined by the sent customized metadata for the populated entity (paragraph [0471]).

As to claim 5, the mobile computing device is selected from a group consisting of a mobile phone and a personal digital assistant (PDA) (paragraph [0354]).

As to claim 6, the customized metadata define data fields of the entities (paragraph [0296]).

As to claim 7, the customized metadata define presentation forms for the entities (paragraph [0296]).

As to claim 8, the storing step e) includes replacing old customized metadata stored in the second data store with at least some of the sent customized metadata (paragraph [0324]).



With respect to claim 15, further to the rejection of claim 1, Kaenel teaches a synchronizer configured to send the customized metadata corresponding to the entities identified in the subscription list to the mobile computing device for storage in the second data store (see paragraph [0269]).

The subject matter of claims 9 – 14 and 16 – 25 are rejected in the analysis above in claims 1 – 8 and 15 and therefore, these claims are rejected on that basis.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 2162

**Contact Information**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2162

16 March 2007